

REMARKS

Claims 1-13 are pending. Claims 1-13 stand rejected.

Claims 1-13 have been amended for grammar and clarification of the claimed subject matter. No new matter is entered.

In the Office Action, the Abstract of the invention was objected to as not being in proper format. Applicant has submitted a substitute Abstract. It is respectfully requested the objection to the Abstract be withdrawn.

Rejections under 35 U.S.C. §101

On page 2 of the Office Action claims 1-6 are rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

It is respectfully submitted that the claims have not been correctly analyzed, and a *prima facie* case setting forth on the record why each invention is not eligible subject matter, as required by MPEP 2106 IV, has not been established.

The Office Action simply presents conclusory statements that the claimed method is not “tangibly embodied as there is no hardware or platform claimed for performing the method.” The Office Action fails to provide any analysis of the claims or reasoning, as required by the Interim Guidelines and the MPEP, for determining patent eligible subject matter.

The analysis for determining patent eligible subject matter under §101 is described in the USPTO Interim Guidelines for Subject Matter Eligibility (Guidelines) as a 4 step process:

1. Does the claimed invention fall within one of the four **statutory categories**?
2. Does the claimed invention fall within a **judicial exception**?
3. Does the claimed invention provide a **practical application**?
4. Does the claimed invention **wholly preempt** all substantial applications of a judicial exception?

All four steps must be applied to each and every claim to form a complete analysis.

In the Office Action, page 2, it is alleged that the method of claim 1 does not recite any hardware. However, claim 1 is clearly directed to a method and falls within one of the four enumerated categories of patentable subject matter (see MPEP 2106). Contrary to the assertions in the Office Action, there is no requirement that a method recite hardware or a platform for performing the method. For example, there is no requirement that a process must be defined by a hardware platform performing the process.

The MPEP does require that the four step analysis be applied to a claim in order to determine whether the claim is directed to patentable subject matter. This analysis has not been performed or explained in the Office Action. According to the MPEP 2106:

The burden is on the USPTO to set forth a *prima facie* case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation. (Emphasis added).

The Office Action only suggests that the “claims raise a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art.” It is unclear from this statement whether the Examiner is arguing that the claims fall under a judicial exception or if the claims merely raise the question. Again, there is no proper analysis offered which would allow the applicant to understand the Examiner’s position. A judicial exception, according to the MPEP, would be abstract ideas (such as mathematical algorithms), natural phenomena, and laws of nature, which are not eligible for patent protection. Clearly the claimed method is not a mathematical algorithm, natural phenomena, or a law of nature.

Because claim 1 does fall within one of the four enumerated categories and does not fall within a judicial exception, the rejection should be withdrawn. Claims 2-5 depend from claim 1 and are likewise directed to patentable subject matter.

With regard to claim 6, applicant repeats the above arguments from claim 1.

For at least the foregoing reasons, the Office has not met the burden of establishing a *prima facie* case setting forth on the record why the invention is not eligible subject matter under 35 U.S.C. §101, and the rejection of claims 1-6 should be withdrawn.

Rejections under 35 U.S.C. §102(e)

According to the Office Action, claims 1-13 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,954,894 (hereinafter "Balnaves"). Applicant respectfully traverses the rejection for at least the following reasons.

To anticipate a claim the reference must either expressly or inherently described *each and every element* as set forth in the claim.

Balnaves fails to teach or suggest many of Applicant's features recited in claim 1. For example, claim 1 recites “positioning a pointer between a range start point and a range end point” and “dividing the range into a first sub range and a second sub range, the first sub range comprising the data from the range start point to the pointer, the second sub range comprising the data from the pointer to the range end point” (emphasis added).

In Balnaves the pointer is positioned along the clip; however, a range is determined from the pointer position. The Office Action argues that points 606 and 607 are the start and end points. Assuming the argument of the Office Action, there can be no “positioning between...” as claimed since, in Balnaves, there is no “zone” until the pointer is positioned (see

fig. 6A, and col. 13). If it is argued that the clip beginning and end is the start and end positions in Balnaves, then Balnaves does not teach at least the above emphasized features of claim 1 because, as shown in fig. 6A of Balnaves, a point before and after the point of interest is determined as a zone around the pointer. There is no sub range from the start point to the pointer and a second sub range from the pointer to the end point in the prior art reference. The range around the indicated point 605 in fig. 6A of Balnaves does not extend to the start point. Nor does the range extend to the end point. A range in Balnaves only extends around the position of the pointer.

In addition, applicant's claim 1 recites: "if the pointer is in a range of unmarked data and a first function is selected, unmarking the first sub range and marking the second sub range, and if the pointer is in a range of marked data and a second function is selected, marking the first sub range and unmarking the second sub range."

It is alleged in the Office Action that these features are described by Balnaves at col. 13, lines 25-45. However, nowhere does Balnaves teach or even suggest the features recited in claim 1. The cited section of Balnaves describes determining or defining the zones of interest around the indicated point 605. Additionally, Balnaves generally states that templates may be defined for alteration or selection of parameters or algorithms or rules. Col. 13, lines 45-47 describes that particular templates must be selected with desired characteristics and applied to clips. However, utilizing templates is completely different from applicant's claimed invention.

At least for the above reasons, applicant submits that Balnaves fails to teach or suggest each and every feature recited in claim 1. Therefore, applicant respectfully requests withdrawal of the rejection and allowance of the claim.

Independent claim 6 recites “moving a pointer to a first position in the representation, executing an expand function for marking the part of the program extending from the first position to the end of the representation, moving the pointer to a second position in the marked part of the program, executing a truncate function for defining as not marked the part of the program extending from the second position to the end of the representation” (emphasis added).

The Office Action only makes conclusory statements that Balnaves discloses the claimed features without providing any indication where Balnaves teaches these features.

After a review of Balnaves it is clear that the claimed features are not found or suggested. Balnaves simply positions the pointer at a point of interest. Thus, the rejection of independent claim 6 is not supported and should be withdrawn.

Independent claim 7 is directed to a recording device. The analysis of claim 7 with regard to Balnaves is analogous to claim 1, as presented hereinabove. To avoid repetition, Applicant's independent claim 7 will not be discussed in detail with the understanding that it is patentable at least for the same reasons as claim 1. Applicant, therefore, respectfully requests withdrawal of the rejection and allowance of claim 7.

Claims 2-5 and 8-13 depend, either directly or indirectly, from independent claims 1 or 7, which have been shown to be allowable over the prior art reference. Accordingly, claims 2-5 and 8-13 are also allowable by virtue of their dependency from the allowable base claims, as well as the additional features recited therein. Applicant submits that the reasons for the rejection of claims 2-5 and 8-13 have been overcome and respectfully requests allowance of those claims.

Conclusion

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. If there are any questions, the Examiner is respectfully requested to call the undersigned attorney at the number listed below. While it is believed no fee is due, please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,



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